

Remarks

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.111 be entered by the Examiner. This amendment adds new claims 76-83. No new matter has been added. New claims 76-83 are supported by the claims and specification as originally filed. Specifically, new claims 76-78 are supported at page 18, lines 2-5 of the original specification. New claims 79-81 are supported at page 19, line 31 through page 20, line 5 of the specification as originally filed. New claim 82 is supported at page 21, lines 29-30 of the original specification. Further, new claim 83 is supported, *inter alia*, at page 18, lines 14-18 and 25-27.

Upon entry of the foregoing amendment, claims 39, 41, 42, and 48-83 are pending in the application, claims 39, 41 and 42 being the independent claims. New claims 76-83 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Restriction Requirement

The Examiner has required restriction to one of eight groups of inventions, Groups I-VIII, under 35 U.S.C. § 121. Group I, represented by claims 39, 54-74, and 75, are drawn to a method of stimulating cell division. Group II, represented by claims 41 and 54-74, are drawn to a method of healing a wound. Group III, represented by claims 42, 48, and 54-74, are drawn to a method of treating ischemic. Group IV, represented by claims 42, 49, and 54-74, are drawn to a method of treating a peripheral vascular disease. Group V, represented by claims 42, 50, and 54-74, are drawn to a method of treating neural injury.

Group VI, represented by claims 42, 51, and 54-74, are drawn to a method of treating gastric ulcer. Group VII, represented by claims 42, 52, and 54-74, are drawn to a method of treating duodenal ulcer. Group VIII, represented by claims 42, 53, and 54-74, are drawn to a method of treating heart disease.

Applicants hereby provisionally elect to prosecute the invention of Group I (claims 39, 54-74, and 75). This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

In support of the Restriction requirement, the Examiner asserts that inventions I-VIII are unrelated referring to M.P.E.P. §§ 806.04 and 808.01. Contrary to this assertion, Applicants believe that the claims of inventions I-VIII are related. The claims are all directed to methods utilizing a mutein of a human basic fibroblast growth factor, or a biologically active peptide thereof, either *in vivo* or *in vitro*, wherein said mutein comprises the substitution of a neutral and/or hydrophobic amino acid for one or more of the following:

- (a) Glutamate 89; or
- (b) Aspartate 101; or
- (c) Leucine 137;

wherein the numbering of amino acids is based on SEQ ID NO:1. Applicants direct the Examiner's attention to the Examiner Note in M.P.E.P. § 808.01, entitled "Unrelated Inventions", which states: "This form paragraph is to be used only when claims are presented to unrelated inventions, *e.g.*, a necktie and a locomotive bearing." Clearly, the claims in this case are related.

M.P.E.P. § 803 (Eighth Edition, August 2001), at page 800-4, left hand column, states as one of the criteria for a proper requirement for restriction that: "There must be a serious burden on the examiner if restriction is required ...". Thus, the Patent Office encourages the search and examination of an entire application on the merits, where such search and examination can be made *without* serious burden.

In the present case, Applicants respectfully assert that the search of restriction groups I-VIII does not impose a serious burden upon the Examiner, as a search concerning the patentability of the invention of one group will clearly uncover art of interest to the other groups. Significantly, the claims of Groups I-VIII have been classified in the *same* class and subclass (514 and 2, respectively), and therefore, can clearly be examined without serious burden on the part of the Examiner. Thus, the claims of Groups I-VIII should be examined together.

Further, restriction practice is not applicable to a single claim. See *In re Weber*, 198 U.S.P.Q. 332 (C.C.P.A. 1978) and its companion case, *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978). These cases make it clear that 35 U.S.C. § 121 does not grant to the U.S. Patent and Trademark Office (PTO) the authority to refuse to examine a single claimed invention. Section 121 only applies to *plural* claimed inventions in *different* claims, wherein the different claims vary not just in scope, but in the invention to which each is directed.



Thus, Applicants submit that in the present case, restriction to one of eight groups of inventions, as required by the Examiner, is improper.

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Reconsideration and withdrawal of the Restriction Requirement, and consideration
and allowance of all pending claims, are respectfully requested

Respectfully submitted,

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Version with markings to show changes made

In the Claims:

New claims 76-83 have been added.